

### **REMARKS**

Claims 1-29 and 31 are pending and stand rejected. Claims 1-29 and 31 stand rejected under 35 USC § 103(a) as being unpatentable over Jones et al. U.S. Pat. 7,349,566 (hereinafter “Jones”) in view of Park et al. U.S. Pat. App. Pub. 2003/0225705 (hereinafter “Park”).

#### **Claim rejections under 35 USC § 103(a)**

The Office action rejected claims 1-29 and 31 under 35 USC § 103(a) as being unpatentable over Jones in view of Park. The Office Action states “Jones does not explicitly disclose generating a negotiable instrument ... However, Park discloses generating a negotiable instrument, wherein the negotiable instruments comprises a check object based upon the image ... (see abstract, also paras 0015).” (p. 2, last line, through p. 3, line 6). Contrary to this assertion, Applicants respectfully maintain that the combination of Jones and Park does not teach or suggest “generating an e-check”, wherein generating the e-check includes generating a negotiable instrument.

To establish a prima facie case of obviousness, the modification or combination must teach or suggest all of Applicants’ claim limitations.<sup>1</sup> The key to supporting any rejection under 35 USC § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.<sup>2</sup> Additionally, all words in a claim must be considered in judging the patentability of the claim against the prior art.<sup>3</sup> Applicants respectfully argue that the combination of Jones in view of Park fails to establish a prima facie case of obviousness for claims 1-29 and 31 because the combination fails to teach or suggest all of Applicants’ claim limitations.

With specific regard to claim 9, the combination fails to teach or suggest

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<sup>1</sup> *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

<sup>2</sup> Manual of Patent Examining Procedure §2142; *KSR International Co. v. Teleflex Inc.*, 550 U.S. 82 USPQ2d 1385, 1396 (2007).

<sup>3</sup> *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

“generating the e-check ... wherein further the e-check is negotiable and in an electronic format”. When properly interpreted, claim 9 describes an e-check that is both 1) in electronic format, and 2) negotiable. Applicants respectfully submit that the combination of Jones and Park **does not teach or suggest an e-check that is both negotiable and in an electronic format**. Examiner relies on Park to provide the elements of “wherein further the e-check is negotiable and in an electronic format”. However, as Applicants will respectfully demonstrate, the electronic file in Park is used to create a negotiable instrument and the electronic file which is used is not negotiable. In other words, Park does not teach or suggest an instrument that is both negotiable and in electronic form. In Park, the negotiable instrument is a paper check.

Park specifically provides that “A first aspect of the present invention is to provide a system for **printing** a negotiable instrument ...” (Park, [0009] with emphasis added). In view of this language, Applicants respectfully argue that Park simply teaches “... **printing** and presenting checks, which are resistant to forgery or fraud” (Park, [0009]), which relate to **paper checks** that are printed. Further support of this argument is found in numerous other parts of the Park specification: “a method of printing a negotiable instrument” (Park, [0015]); “a secure check printing and payment verification system” (Park, [0040]); “each payment system ... prints secure negotiable instruments” (Park, [0042]); “to issue a check payment by printing a secure negotiable instrument” (Park, [0044]); “The secure negotiable instrument 32a that is printed by the check printer” (Park, [0045]); “the payment module 16a to print a sequence of one or more secure negotiable instruments” (Park, [0066]). Applicants respectfully argue that **paper checks are not in electronic format**.

With respect to Examiner’s argument, that Park teaches “...wherein the negotiable instrument comprises the e-check ...” and “...the e-check is in an electronic format”, Applicants address some misleading language in the specification of Park. In particular, Park describes “The method further comprises generating a negotiable instrument image file, the image file comprising ...” (Park, [0015]). Applicants stress

that “negotiable instrument image file” is misleading, because one may misinterpret such language to mean that the image file is negotiable. However, as Applicants have demonstrated, Park only uses the image file to create or print negotiable instruments (Park, [0015], [0040], [0042], [0044], [0045], [0066]). Stated alternatively, the image file in Park is used to create a negotiable instrument, but the image file itself is not negotiable. Upon reading the specification of Park in proper context, Applicants argue that “negotiable instrument image file” is simply an image file used to create a negotiable instrument.

Further, applicants submit that the inclusion of Park in the combination actually teaches away from creating a negotiable instrument that is the form of an e-check. What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact.<sup>4</sup> A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by applicant.<sup>5</sup> Applicants argue that creating a paper check, as taught by Park, certainly lead in a direction divergent from creating an e-check negotiable instrument, which is in digital form.

In light of the above discussion specific to claim 9, Applicants again respectfully argue that neither Park nor the combination of Jones and Park disclose all of the elements of claims 1, 9, 17, and 23. Accordingly, Applicants respectfully traverse rejections of obviousness in regard to independent claims 1, 9, 17, and 23 and request that the claims be allowed.

In regard to claims 2-29 and 31, claims 2-29 and 31 depend from independent claim 1, 9, 17, and 23. If an independent claim is nonobvious under 35 USC § 103, then

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<sup>4</sup> *In re Bell*, 991 F.2d 781, 784, 26 U.S.P.Q.2d (BNA) 1529, 1531 (Fed. Cir. 1993).

<sup>5</sup> *In re Kahn*, 441 F.3d 977, 990, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994)).

any claim depending therefrom is nonobvious.<sup>6</sup> As noted above, Applicants respectfully maintain that independent claims 1, 9, 17, and 23 are not obvious and that the rejections are traversed. Because the rejections of claims 2-29 and 31 are predicated upon the obviousness of claims 1, 9, 17, and 23, Applicants respectfully traverse the rejections of dependent claims 2-29 and 31 and request that the claims be allowed.

### **Claim 1 amendment**

Applicants believe that the previously submitted versions of claims 1-29 and 31 are patentable over the combination of Jones and Park. However, to expeditiously prosecute the application and clearly demarcate a patentable embodiment that is clearly different from the teachings and suggestions of Jones and Park, Applicants are proposing an amendment to independent claim 1. In proposing the amended claim, Applicants are not conceding that the subject matter encompassed by claim 1 prior to the proposed amendment is unpatentable over Jones and Park, as well as other prior art previously cited by Examiner. Applicants respectfully reserve the right to pursue the claims in one or more continuing applications, including claims capturing the subject matter encompassed by the previous versions of claims 1, 9, 17, and 23, as well as other additional claims.

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<sup>6</sup> *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

### **CONCLUSION**

Applicants have argued why the combination of Jones and Park does not teach all of the claim limitations of Applicants. To expedite prosecution, however, Applicants also propose an amended version of independent claim 1 that is clearly different from the claimed subject matter from the teachings and suggestions of Jones and Park. Consequently, Applicants believe they have fully responded to the arguments made by the Examiner. Applicants believe that the pending claims are in condition for allowance. Thus, Applicants request that the pending claims be allowed and that the application advance toward issuance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at (409)-789-7207.

An extension of time fee accompanies the filing of this response. No other fees are believed due with this filing. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

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/Garland D Charpiot/

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Date

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